

4w



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,016	01/29/1999	MASAMICHI ITO	35.C13284	5590

5514 7590 02/14/2005

FITZPATRICK CELLA HARPER & SCINTO
 30 ROCKEFELLER PLAZA
 NEW YORK, NY 10112

EXAMINER

POON, KING Y

ART UNIT PAPER NUMBER

2624

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,016

Applicant(s)

ITO, MASAMICHI

Examiner

King Y. Poon

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004 and 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,9,10 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9,10 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2004 and 7/19/2004 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 5, 6, 9, 10, 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1: It is unclear the limitation "the specific information" found in line 9 is referring to the specific information of line 3 (generated) or the specific information of line 6 (recorded) or the specific information of lines 7-8 (reproduced). It is unclear the limitation "the image data" found in lines 9-10 is referring to the image data of line 5 (recorded) or the image data of line 7 (reproduced), or image data of line 2 (captured).

Regarding claim 5: It is unclear the limitation "the specific information" found in line 9 is referring to the specific information of line 4 (generated) or the specific information of lines 5-6 (recorded) or the specific information of line 7 (reproduced). It is unclear the limitation "the image data" found in line 9 is referring to the image data of line 5 (recorded) or the image data of line 7 (reproduced) or image data of line 3 (captured).

Regarding claim 9: It is unclear the limitation "the specific information" found in line 9 is referring to the specific information of line 4 (generated) or the specific information of lines 5-6 (recorded) or the specific information of line 7 (reproduced). It is unclear the limitation "the image data" found in line 9 is referring to the image data of line 5 (recorded) or the image data of line 7 (reproduced) or image data of line 3 (captured).

Claims 2, 6, 10, 13-19 are rejected under 35 U.S.C. 112, second paragraph because they depend on rejected claims 1, 5, 9.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or except that an international application filed under the treaty defined in section 351 (a) shall have the effects under this subsection of a national application published under 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in

Art Unit: 2624

the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 2, 5, 6, 9, 10, 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (US 6,122,403).

Regarding claim 1: Rhoads teaches an image capture apparatus (the computer that is to reproducing an image, such as a video, column 72, lines 15-23, with added watermarks, column 69, lines 49-56, and the scanning device, column 69, lines 50-55) which records data of a captured image on a recording medium (the recording medium that stores the image file, column 69, lines 50-60, scanned by the image scanner; since the computer is loaded with the image file scanned by the image scanner, inherently, the computer must process a memory for storing the image file to prevent the image file from being lost) comprising: an image capture unit (scanning device, column 69, lines 50-55) adapted to capture an image; an information generation unit (the computer program that generates data of a logo that is being stored in a file of the computer, column 68, lines 40-45; other information can be generated are e.g., messages or user's name etc, column 69, lines 10-30, column 73, lines 15-50) adapted to generate specific information (e.g., ID, adult content information, logo, copyright symbol, column 73, lines 25-50, column 69, line 66); a recording unit adapted to record image data obtained from the captured image and the specific information on a recording medium (the recording medium in the computer that stores the image file, column 69, lines 50-60 or the symbol, column 69, line 66, etc.); a reproducing unit (the computer program that recover a watermarked image, column 69, lines 57-67, column 70, lines 1-45) adapted to reproduce the image data and the specific information from the recording medium

Art Unit: 2624

(the memory of the computer that is storing the image file, column 69, lines 49-56); an embedding unit (writer, column 69, line 34) adapted to embed specific information (e.g., Creator ID, column 69, line 42) into the image data using a digital watermarking technique (column 69, lines 32-35); and a selection unit (the program of the computer that sense the OK selection and embedded the watermark into image data, column 73, lines 45-50, or cancel the process, and the software that downloads the image file to a local computer, column 69, lines 49-55, column 72, lines 50-55) adapted to select a first process (embed the watermark, column 73, lines 45-50) or a second process (abort the process, column 73, lines 45-50) in accordance with user's instruction, wherein when the first process is selected, the embedding unit embeds the specific information into the image data (column 73, lines 45-50); and when the second process is selected, the embedding unit avoids embedding the specific information into the image data (column 73, lines 45-50).

Regarding claim 2: Rhoads teaches wherein the embedding unit is adapted to embed the specific information into the decompressed image data. (Column 71, lines 10-15).

Regarding claim 13: Rhoads teaches wherein the apparatus generates the specific information when the image is captured (column 69, lines 50-56, column 72, lines 49-50).

Regarding claim 16: Rhoads teaches the apparatus further comprising an outputting unit adapted to output the image data to a destination external to the image capturing apparatus, wherein when the first process is selected, the outputting unit

Art Unit: 2624

outputs the image data including the specific information to the external destination, and wherein, when the second process is selected; the outputting unit outputs the image data excluding the specific information to the external destination.

Regarding claims 5, 6, 14, 17: Claims 5, 6, 14, 17 are claiming method steps for the apparatus discussed in claims 1, 2, 13, 16. Please see discussion on claims 1, 2, 13, 16.

Regarding claims 9, 10, 15, 18: Rhoads teaches to use a computer, running software programs (column 67, lines 55-62) for carrying out the method steps discussed in claims 1, 2, 13, 16. It is inherent that a software program is stored in a storage program.

Response to Arguments

6. Applicant's arguments filed on 7/19/2004 have been fully considered but they are not persuasive.

With respect to applicant's argument that Rhoads does not teach an image capture unit having 1) capturing an image, 2) generating specific information relating to the image data 3) recording the captured image and the specific information, and 4) selectively embedding the specific information generated by the image capture apparatus in the image capture by the image capture apparatus, has been considered.

In reply: Rhoads teaches an image capture apparatus (the computer that is to reproducing an image, such as a video, column 72, lines 15-23, with added watermarks, column 69, lines 49-56, and the scanning device, column 69, lines 50-55) which records

Art Unit: 2624

data of a captured image on a recording medium (the recording medium that stores the image file, column 69, lines 50-60, scanned by the image scanner; since the computer is loaded with the image file scanned by the image scanner, inherently, the computer must process a memory for storing the image file to prevent the image file from being lost) comprising: an image capture unit (scanning device, column 69, lines 50-55) adapted to capture an image; an information generation unit (the computer program that generates data of a logo that is being stored in a file of the computer, column 68, lines 40-45; other information can be generated are e.g., messages or user's name etc, column 69, lines 10-30, column 73, lines 15-50) adapted to generate specific information (e.g., ID, adult content information, logo, copyright symbol, column 73, lines 25-50, column 69, line 66); a recording unit adapted to record image data obtained from the captured image and the specific information on a recording medium (the recording medium in the computer that stores the image file, column 69, lines 50-60 or the symbol, column 69, line 66, etc.); a reproducing unit (the computer program that recover a watermarked image, column 69, lines 57-67, column 70, lines 1-45) adapted to reproduce the image data and the specific information from the recording medium (the memory of the computer that is storing the image file, column 69, lines 49-56); an embedding unit (writer, column 69, line 34) adapted to embed specific information (e.g., Creator ID, column 69, line 42) into the image data using a digital watermarking technique (column 69, lines 32-35); and a selection unit (the program of the computer that sense the OK selection and embedded the watermark into image data, column 73, lines 45-50, or cancel the process, and the software that downloads the image file to a

Art Unit: 2624

local computer, column 69, lines 49-55, column 72, lines 50-55) adapted to select a first process (embed the watermark, column 73, lines 45-50) or a second process (abort the process, column 73, lines 45-50) in accordance with user's instruction, wherein when the first process is selected, the embedding unit embeds the specific information into the image data (column 73, lines 45-50); and when the second process is selected, the embedding unit avoids embedding the specific information into the image data (column 73, lines 45-50).

With respect to applicant's argument that Rhoads creates creators ID by using a MarcCenter which creates a user identification, has been considered.

In reply: Column 69, lines 33-45 clearly teaches embedding watermark is performed by a writer portion of software PictureMarc and the watermark information such as a copyright symbol can be generated by scanning an existing embedded image file, column 69, lines 60-67, or a message or a person's name can be entered into the computer, column 69, lines 10-30 column 67, lines 40-50, or a logo can be generated by extracting images form web pages, column 68, lines 40-50.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892



**KING Y. POON
PRIMARY EXAMINER**

February 10, 2005